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From: Ned.Israelsen

Sent: Tuesday, October 09, 2007 7:50 PM

To: Markush.Comments

Subject: Comments of San Diego Intellectual Property Law Association

Please find attached the comments of the San Diego Intellectual  
Property

Law Association on the new proposed Markush rules.

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## COMMENTS OF SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION ON PROPOSED USPTO RULES PACKAGE:

### “Examination of Patent Applications That Include Claims Containing Alternative Language”

October 9, 2007

via email: [markush.comments@uspto.gov](mailto:markush.comments@uspto.gov)

#### Attention:

Kathleen Kahler Fonda, Legal Advisor  
Office of the Deputy Commissioner for Patent Examination Policy

#### INTRODUCTION

The San Diego Intellectual Property Law Association (SDIPLA) is a nonprofit membership organization of attorneys and others in the San Diego area who are interested in intellectual property law issues. The SDIPLA now has more than 475 members, including representatives from law firms, in house counsel, the investment community, and academia.

#### BACKGROUND

The proposed Markush rules represent a significant source of concern for SDIPLA. We agree with the comments of BIOCOM, submitted concurrently herewith. Rather than repeat all of the BIOCOM comments, we would like to emphasize a few points of particular concern.

We note first that it has been the nature of scientific progress that basic discoveries and pioneering inventions are followed by improvement inventions falling within the scope of that earlier work. Genus inventions are followed by species inventions. The television invention, for example, was followed by color television, remote controlled television, televisions with stereo sound, television with flat CRTs, high definition television, and thousands of other separately patentable improvements that fall within the broad scope of the pioneer television invention. Sometimes only the genus is disclosed in an application; sometimes species or improvements are disclosed as well.

Markush terminology is often used to define or create a genus, particularly when the limitations of language do not provide a ready-made generic term encompassing the relevant subject matter. In such cases, it appears from the proposed rules that the PTO is attempting to restrict the right of inventors to adequately define and claim their generic inventions when doing so would require the use of alternative language. This is clearly contrary to the precedent of *In re Weber*<sup>1</sup> and *In re Harnisch*.<sup>2</sup> Those cases support the right of applicants to define their

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<sup>1</sup> 580 F.2d 455 (CCPA 1980).

inventions as broadly as they envision them, rather than artificially dividing the invention up into pieces and claiming the pieces individually. As an example, if the original television disclosure included not only a disclosure of a TV with a primitive CRT, but also flat CRTs, CRTs with square corners, color CRTs, and remote control circuits, the underlying philosophy of the new rules would mandate separate patents on all of the species, rather than one patent on the genus. It is clear, however, that the whole (i.e., the generic claim) is greater than the sum of the parts (a collection of species claims).

This very principle was at the heart of *In re Weber*. The CCPA clearly stated that an applicant has “the right to claim his invention with the limitations he regards as necessary to circumscribe that invention,” and that Section 112 “allows the inventor to claim the invention as he contemplates it.”<sup>3</sup> The court then noted that:

If, however, a single claim is required to be divided up and presented in several applications, that claim would never be presented on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim.<sup>4</sup>

The Weber court recognized that examining a complex Markush claim can be burdensome. However, it held that:

[I]n drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights are paramount. We hold that [the improper Markush rejection] violates the basic right of the applicant to claim his invention as he chooses.<sup>5</sup>

## THE PROPER STANDARD FOR MARKUSH CLAIMS

*In re Weber* and *In re Harnisch* unmistakably set forth the current standard for whether a Markush or other alternative claim is proper. As *Weber* made clear, the standard is not whether a claim encompasses multiple, separately-patentable inventions. Instead, as set forth in *Harnisch*, it is whether the various embodiments encompassed by the broad claim are:

part of a single invention so that there is unity of invention.<sup>6</sup>

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<sup>2</sup> 631 F.2d 716 (CCPA 1980).

<sup>3</sup> *In re Weber* 580 F.2d at 458.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at 458-459.

<sup>6</sup> 651 F.2d 715, 722.

In *Harnisch*, it was clear that the “unity of invention” standard is a broad and inclusive standard that is easily met. In that case, the claim was held to satisfy that standard, because the compounds it encompassed were all coumarin dyes, despite vast structural differences. Although the case recognizes that unity of invention may be lacking for inventions that are truly independent and distinct, such inventions are characterized as “unrelated.”<sup>7</sup>

The reference in footnote 7 of *Harnisch* to rulemaking to deal with situations in which a Markush claim encompassed independent and distinct inventions was not an invitation to broad rulemaking to dramatically restrict Markush practice. Instead, consistent with these judicial decisions, it only invited rules addressing those relatively rare situations in which *unrelated* inventions are encompassed within a single claim. Where the inventions encompassed by a single claim share a common property, or are structurally related, even though patentably distinct, they cannot be separated by the USPTO.

## GENERAL COMMENTS ON RULES PACKAGE

The SDIPLA believes that the new rules package is directly contrary to binding precedent, e.g., *In re Weber*, which elevates the applicant’s right to claim an invention as they envision it above the administrative convenience of the USPTO.

The new rules reflect a disturbing trend of USPTO antipathy toward important, pioneering, or complex inventions. Such inventions, by their very nature, encompass broad new areas of technology, as well they should. They are not susceptible to being packaged up into lots of little patents, with a limited number of independent and dependent claims. They are not necessarily susceptible of simple definition, but often require claims of complex structure that define portions of the invention with multiple alternative definitions. The creative genius underlying such major inventions should be rewarded, not punished. USPTO rules should not emphasize administrative convenience to the point that an inventor’s ability to secure protection for the full, lawful scope of an invention is compromised. The proposed Markush rules do just that.

For all of these reasons, rules that artificially parse a claimed inventive concept expressed in alternative form into separate, smaller pieces is violative of established precedent.

## COMMENTS ON SPECIFIC RULES

### *1.75(d)(2):*

The SDIPLA objects to the inclusion of this new provision, that would place a major burden on applicants to affirmatively point out support in parent cases, whether or not such support is relevant due to intervening prior art. The status quo works perfectly well. If the availability of a priority date for a particular claim is relevant due to intervening prior art, the USPTO can reject the claim unless support in the parent is demonstrated by the applicant.

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<sup>7</sup> *Id.*

*1.75(j)(1):*

This rule proscribes alternative language in claims that make them “difficult to construe.” By their very nature, many chemical, biological, and other complex inventions are difficult to understand, and complex claim structures may well be necessary to adequately protect them. This rule violates the “right of the applicant to claim the invention as he chooses,” set forth in *Weber, supra*. The statute already proscribes claims that are indefinite; anything more violates Section 112.

*1.75(j)(2)*

This rule forbids an alternative (e.g., halogen) as being defined as a set of further alternatives within the claim (e.g., chlorine or bromine). There is no clear public policy reason for this rule, and for reasons discussed above, it violates the fundamental right of inventors to claim their inventions. It further penalizes inventors who make complex inventions, thereby “dumbing down” the patent system.

*1.75(j)(3)*

This rule says that no alternative can be encompassed by another alternative. This merely creates a trap for the unwary in examination of complex claims and serves no compelling countervailing purpose.

*1.75(j)(4)*

The requirement that each member of the Markush group should be substitutable for each other one is also a minefield. The word “substitutable” could be interpreted broadly or narrowly, as “merely operable” or “equivalent.” There is no requirement that all members of the group be equivalent. Moreover, even the inclusion of some inoperable embodiments in a claim has been held to be permissible.

*1.40*

This section requires that all members of the group share a substantial feature essential for a common utility. The example in the rules package, of staples, glue, and tape not coexisting in the same claim, is simply unworkable. These elements all perform a function of fastening things together and in many instances would all constitute a common inventive concept. They are clearly “related” by their common utility, and separation would violate *Harnisch* (under which inventions are independent and distinct only if “unrelated”). It is especially concerning that the PTO indicates that this same invention would be patentable in a single claim if expressed as the existing generic term “fasteners” rather than the narrower, artificial genus of staples, glue and tape.

## CONCLUSION

For all of these reasons, the SDIPLA opposes the new rules package as unnecessary and as violative of the clear right of an applicant to define his or her invention as enunciated by governing case law. It would make it more difficult and sometimes impossible for inventors to secure patent claims to the full, lawful scope of their invention, and would have a negative impact on American innovation and global competitiveness.

Sincerely,

San Diego Intellectual Property Law Association  
Ned A. Israelsen, Amicus Committee Chairman

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